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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/556,143

04/21/2000

Ronald A. Schachar

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EXAMINER

SHAY, DAVID M

ART UNIT

PAPER NUMBER

3735

MAIL DATE

DELIVERY MODE

01/08/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/556,143	Applicant(s) SCHACHAR, RONALD A.	
	Examiner david shay	Art Unit 3735	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on August 31, 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 40-59 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 40-59 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

A request for continued reconsideration of the finality of the previous office action notes that in addition to amendments to claim 40, filed with the Request for Continuing Examination filed April 12, 2007, and not included in the after final submission prior to the Request for continuing Examination filed April 12, 2007, that the amendment to claim 54, which was included in the aforementioned After Final submission and not entered as per the Advisory Action of March 13, 2007, was also filed with the Request for Continuing Examination filed April 12, 2007. Thus the finality of the office action mailed June 29, 2007 was improper and the submission filed August 31, 2007 has been entered.

Applicant's arguments with respect to the Declaration are noted, but do not remedy the situation (see the Decision on Petition of December 17, 2007, especially the BACKGROUND and ANALYSIS thereof).

The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

It is a copy of the oath submitted in the parent case, when the instant application is not a continuation of the parent case.

The specification to which the oath or declaration is directed has not been adequately identified. See MPEP § 602.

This application presents a claim for subject matter not originally claimed or embraced in the statement of the invention: the use of a laser. A supplemental oath or declaration is required under 37 CFR 1.67. The new oath or declaration must properly identify the application of which

it is to form a part, preferably by application number and filing date in the body of the oath or declaration. See MPEP §§ 602.01 and 602.02.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 40-59 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by March et al.

March et al teach removing scleral tissue by irradiating it with a laser to treat glaucoma, and that prior art laser procedures to treat glaucoma did not create “a complete scleral perforation”. Stedman’s Medical Dictionary defines ablate as “to remove”; abrade as “to wear away by mechanical action”; and incise as “to cut with a knife” since the laser produces no mechanical action per se and is not a knife per se, abrade will be construed to indicate wearing away by action of the light and incise will be construed to indicate cutting by action of the light. Since the laser burns through the sclera at the treatment site, there must be some tissue interposed the margin of the treatment site and the boundary beyond which the scleral tissue is not affected by the treatment wherein the collagen fibers are partially decomposed.

Applicant argues that the examiner has not provided a sufficient showing of inherency, alleging that the examiner “never shows that this [increase an effective working distance of the ciliary muscle] occurs” as a result of the treatment in March et al. For an exhaustive treatment of this issue, applicant is referred to the office action mailed December 15, 2006, which is incorporated herein by reference, particularly pages 2-4 thereof and the Advisory Action mailed March 13, 2007, which is also incorporated by reference herein. The examiner further respectfully submits that it is undeniable that the method of March et al (as well as the prior art

methods, discussed in the office action mailed June 29, 2007, which is also incorporated herein by reference) removes a portion of the sclera, rendering it thinner at the point of the incision. Since, for the purposes of the instant invention, the sclera “may be thinned or weakened by the surgical removal of a portion of its collagenous substance, as, for example by ablating a portion of the thickness of the sclera” (see the originally filed disclosure, page 20, lines 20-22), either the method of March et al weakens the sclera, with all the attendant results asserted by applicant, or the instant method is not enablingly disclosed. Thus applicant’s arguments are not convincing.

Applicant's arguments filed August 31, 2007 have been fully considered but they are not persuasive. The arguments are not persuasive for the reasons set forth above.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to david shay whose telephone number is (571) 272-4773. The examiner can normally be reached on Tuesday through Friday from 6:30 a.m. to 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Marmor, II, can be reached on Monday, Tuesday, Wednesday, Thursday, and Friday. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/david shay/

Primary Examiner, Art Unit 3735